

REMARKS

In the Office Action mailed May 4, 2004, Claims 2, 5-11 and 21 are rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,187,892 issued to Markusch et al. Claims 12-14, 19-22 and 25-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,187,892 issued to Markusch et al. Claims 3, 4, 23 and 24 are rejected under 35 U.S.C. §102(e), as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,187,892 issued to Markusch et al. as applied to Claims 2 and 19.

Rejections under 35 U.S.C. §102(e)

Claims 2, 5-11 and 21 stand rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,187,892 issued to Markusch et al. Applicants respectfully disagree with the Examiner's contention regarding Markusch et al.

Applicants respectfully remind the Examiner that as stated in MPEP §2131, to anticipate a claim, a reference must teach every element of that claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully contend that the Examiner has failed to point to where Markusch et al. teach impregnating a geotextile or any textile with their polyurethane composition. According to Websters Ninth New Collegiate Dictionary, page 606 (copy attached), impregnate means to cause to be filled, imbued, permeated, or saturated. Markusch et al. state at col. 2, lines 13-16, that in their invention,

The viscosity of the reacting adhesives is sufficiently high so that the compositions **do not soak into porous substrates and thus remain on the surface** of the substrate where they maintain their effectiveness as adhesive layers. (Emphasis added)

Thus, the disclosure of Markusch et al. does not describe the instantly claimed invention.

Therefore, Applicants respectfully request the Examiner reconsider and reverse her rejection of Claims 2, 5-11 and 21 under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,187,892 issued to Markusch et al.

Rejections under 35 U.S.C. §103(a)

Claims 12-14, 19-22 and 25-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,187,892 issued to Markusch et al. Applicants respectfully disagree with the Examiner's contention regarding Markusch et al.

Applicants respectfully remind the Examiner of the Federal Circuit's admonition given in *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1458-9 (Fed. Cir. 1998) that,

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Applicants respectfully contend that the Examiner has failed to do so in the instant Office Action.

As stated in MPEP §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, citing *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Clearly there is no such teaching, suggestion or motivation shown in the reference in this case to modify a polyurethane composition that will not soak into a porous surface into one which will impregnate a geotextile. If the Examiner is relying on knowledge generally available to one of ordinary skill in the art, MPEP §2144.03 states that if applicants traverse such an assertion, the Examiner should cite a reference in support of her position. Applicants do traverse the Examiner's assertion in the case and hereby request such a reference. If the Examiner is relying on facts

within her personal knowledge, applicants respectfully request and are calling for, pursuant to MPEP §2144.03 and 37 C.F.R. §1.104, the Examiner to support such facts by an Affidavit.

If the Examiner continues to maintain her rejection, applicants respectfully request she point with particularity to those portions of Markusch et al. which indicate modifying their polyurethane composition which will not soak into a porous surface into one which will impregnate a geotextile. Applicants have found no such teaching in Markusch et al. It is well established that a reference which does not recognize a problem can not suggest a solution. *In re Shaffer*, 108 USPQ 326 (CCPA 1956).

Therefore, applicants contend that nothing in the teaching of Markusch et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claims 12-14, 19-22 and 25-32 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,187,892 issued to Markusch et al.

Rejections under 35 U.S.C. §§102(e)/103(a)

Claims 3, 4, 23 and 24 stand rejected under 35 U.S.C. §102(e), as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,187,892 issued to Markusch et al. as applied to Claims 2 and 19 above. Applicants respectfully disagree with the Examiner's contention regarding Markusch et al.

As stated above in reply to the rejections under 35 U.S.C. §102(e) and under 35 U.S.C. §103(a), Markusch et al. neither teaches nor suggests a polyurethane composition capable of impregnating a geotextile.

Therefore, Applicants respectfully request the Examiner reconsider and reverse her rejection of Claims 3, 4, 23 and 24 under 35 U.S.C. §102(e), as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,187,892 issued to Markusch et al.

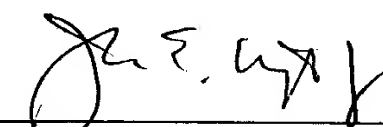
Conclusion

Applicants have amended Claims 2, 19, 21 and 32. Such amendment is to be construed as "truly cosmetic" and is not believed to narrow the scope of the claims or raise an estoppel within the meaning of *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., et al.*, 535 U.S. 722 (2002). Applicants also contend that such claim amendments add no new matter and find support in the specification.

Applicants submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 2-14 and 19-32. If the Examiner is of the opinion that the instant application is in condition for other than allowance, she is invited to contact the Applicants' Attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

Respectfully submitted,

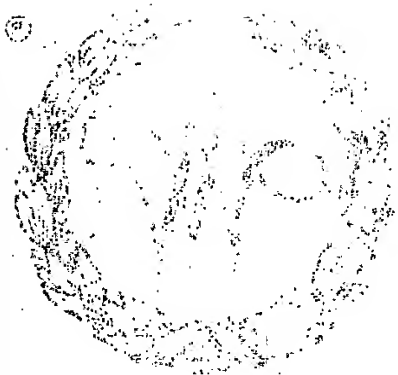
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im-preg-na-ble \im-'preg-nə-bəl\ *adj* [ME *imprenable*, fr. MF, fr. *in-* + *prenable* vulnerable to capture, fr. *prendre* to take — more at **PRIZE**] (15c) 1 : incapable of being taken by assault : UNCONQUERABLE 2 : UNASSAILABLE; also : IMPENETRABLE — **im-preg-na-bil-i-ty** \im-'preg-nə-bəl-ē\ *n* — **im-preg-na-ble-ness** \im-'preg-nə-bəl-nəs\ *n* — **im-preg-na-bly** \im-'preg-nə-bəl\ *adv*

im-preg-nant \im-'preg-nənt\ *n* (1926) : a substance used for impregnating another substance

im-preg-nate \im-'preg-nāt, 'im- \ *vt* -nat-ed; -nat-ing [LL *im-pregnatus*, pp. of *impraegnare*, fr. L *in-* + *praegnare* pregnant] (1605) 1 a : to cause to be filled, imbued, permeated, or saturated b : to permeate thoroughly 2 : to make pregnant : FERTILIZE *syn* see **SOAK** — **im-preg-na-tion** \im-'preg-nā-shən\ *n* — **im-preg-na-tor** \im-'preg-nā-tər, 'im- \ *n*

im-preg-nate \im-'preg-nāt\ *adj* (1646) : being filled or saturated

im-pre-sa \im-'prə-zə, -sə\ *n* [It, lit., undertaking] (1588) : a device with a motto used in the 16th and 17th centuries; broadly : EMBLEM

im-pre-sa-rio \im-'prə-sār-ē, -sə-, -zār- \ *n*, pl -ri-os [It, fr. *impresa* undertaking, fr. *impredere* to undertake, fr. (assumed) VL *imprehen-dere* — more at **EMPRISE**] (1746) 1 : the promoter, manager, or conductor of an opera or concert company 2 : one who puts on or sponsors an entertainment (as a television show or sports event) 3 : MANAGER, DIRECTOR

im-press \im-'pres\ *vb* [ME *impressen*, fr. L *impressus*, pp. of *imprimere*, fr. *in-* + *primere* to press — more at **PRESS**] (14c) 1 a : to apply with pressure so as to imprint b : to produce (as a mark) by pressure c : to mark by or as if by pressure or stamping 2 a : to produce a vivid impression of b : to affect esp. forcibly or deeply : INFLUENCE 3 a : TRANSFER, TRANSMIT b : to transmit (force or motion) by pressure; esp : to apply (as voltage) to a circuit from an outside source ~ *vi* : to produce an impression *syn* see **AFFECT**

im-press \im-'pres also im- \ *n* (1590) 1 : a characteristic or distinctive mark : STAMP (the ~ of a fresh and vital intelligence is stamped in his work — Lytton Strachey) 2 : IMPRESSION, EFFECT (have an ~ on history) 3 : the act of impressing 4 a : a mark made by pressure : IMPRINT b : an image of something formed by or as if by pressure : esp : SEAL c : a product of pressure or influence

im-press \im-'pres\ *vt* [in- + *press*] (1596) 1 : to levy or take by force for public service; esp : to force into naval service 2 a : to procure or enlist by forcible persuasion b : FORCE (~ed him into a white coat for the Christmas festivities — Nancy Hale)

im-press \im-'pres also im- \ *n* (1602) : IMPRESSMENT

im-press-ible \im-'pres-ə-bəl\ *adj* (15c) : capable of being impressed : SENSITIVE — **im-press-ibil-i-ty** \im-'pres-ə-bil-ē\ *n* — **im-press-ibly** \im-'pres-ə-bəl\ *adv*

im-pression \im-'resh-ən\ *n* (14c) 1 : the act of impressing; as a : an affecting by stamping or pressing b : a communicating of a mold, trait, or character by an external force or influence 2 : the effect produced by impressing; as a : a stamp, form, or figure resulting from physical contact b : an imprint of the teeth and adjacent portions of the jaw for use in dentistry c : an esp. marked influence or effect on feeling, sense, or mind 3 a : a characteristic, trait, or feature resulting from some influence (the ~ on behavior produced by the social milieu) b : an effect of alteration or improvement (the settlement left little ~ on the wilderness) c : a telling image impressed on the senses or the mind 4 a : the amount of pressure with which an inked printing surface deposits its ink on the paper b : one instance of the meeting of a printing surface and the material being printed; also : a single print or copy so made c : all the copies (as of a book) printed in one continuous operation from a single makeready 5 : a usu. indistinct or imprecise notion or remembrance 6 a : the first coat of color in painting b : a coat of paint for ornament or preservation 7 : an imitation or representation of salient features in an artistic or theatrical medium; esp : an imitation in caricature of a noted personality as a form of theatrical entertainment *syn* see **IDEA**

im-pression-able \im-'resh-ə-nə-bəl\ *adj* (1836) : capable of being easily impressed — **im-pression-abil-i-ty** \im-'resh-ə-nə-bil-ē\ *n*

im-pression-ism \im-'resh-ə-niz-əm\ *n* (1882) 1 often *cap* : a theory or practice in painting esp. among French painters of about 1870 of depicting the natural appearances of objects by means of dabs or strokes of primary unmixed colors in order to simulate actual reflected light 2 a : the depiction of scene, emotion, or character by details intended to achieve a vividness or effectiveness more by evoking subjective and sensory impressions than by recreating an objective reality b : a style of musical composition designed to create subtle moods and impressions

im-pression-ist \im-'resh-ə-nəst\ *n* (1881) 1 often *cap* : one (as a painter) who practices or adheres to the theories of impressionism 2 : an entertainer who does impressions

im-pression-is-tic \im-'resh-ə-nis-tik\ *adj* (1886) 1 or **im-pression-ist** \im-'resh-ə-nəst\ : of, relating to, or constituting impressionism 2 : based on or involving impression as distinct from knowledge or fact (intuitions and ~ anecdotal accounts — Sidney Hook) — **im-pression-is-ti-cal-ly** \im-'resh-ə-nis-ti-k(ə)-lē\ *adv*

im-pres-sive \im-'pres-iv\ *adj* (1598) : making or tending to make a marked impression *syn* see **MOVING** — **im-pres-sive-ly** *adv* — **im-pres-sive-ness** *n*

im-press-ment \im-'pres-mənt\ *n* (1787) : the act of seizing for public use or of impressing into public service

im-pres-sure \im-'pres-ər\ *n*, archaic (1600) : a mark made by pressure : IMPRESSION

im-prest \im-'prest\ *n* [obs. *imprest* (to lend), prob. fr. It *imprestare*] (1568) : a loan or advance of money

im-pri-ma-tur \im-'prā-mā-tū(ə)r, im-'prim-ə-t(y)ū(ə)r\ *n* [NL, let it be printed, fr. *imprimere* to print, fr. L, to imprint, impress — more at **IMPRESS**] (1640) 1 a : a license to print or publish esp. by Roman Catholic episcopal authority b : approval of a publication under circumstances of official censorship 2 a : SANCTION, APPROVAL b : IMPRINT c : a mark of approval or distinction

im-pri-mis \im-'pri-məs, -prē-\ *adv* [ME *imprimis*, fr. L *in primis* among the first (things)] (15c) : in the first place — used to introduce a list of items or considerations

im-print \im-'print, 'im- \ *vt* (14c) 1 : to mark by or as if by pressure : IMPRESS 2 a : to fix indelibly or permanently (as on the memory) b

: to subject to or induce by imprinting (an ~ed preference)

undergo imprinting — **im-print-er** \-ər\ *n*

im-print \im-'print\ *n* [MF *empreinte*, fr. fem. of *empreindre*, pp. of *empreindre* to imprint, fr. L *imprimere*] (15c) : something imprinted; as a : a mark or depression made by pressure (the fossil of a dinosaur's foot) b : an identifying name (as of a publisher) printed conspicuously on a product (as at the foot of the title page of a book) also : the name under which a publisher issues books c : an im-

distinguishing effect or influence

im-print-ing \im-'print-ing, im- \ *n* (ca. 1937) : a rapid learning process that takes place early in the life of a social animal (as a greyhound) and establishes a behavior pattern (as recognition of and attraction to its own kind or a substitute)

im-pris-on \im-'priz-ən\ *vt* [ME *imprisonen*, fr. OF *emprisoner*, fr. *in-* + *pris* to put in or as if in prison : CONFINE — **im-pris-on-ment** \im-'priz-ən-mənt\ *n*

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im-prob-a-ble \im-'prəb-(ə)-bəl\ *adj* [MF or L; MF, fr. L *improbabilis* unlikely but real or true — **im-prob-a-bil-i-ty** \im-'prəb-(ə)-bəl-ē\ *n* — **im-prob-a-bly** \im-'prəb-(ə)-bəl\ *adv*

im-promp-tu \im-'prəm(p)-t(y)ū\ *n* [F, fr. *impromptu* extemporaneously, fr. L *in promptu* in readiness] (1683) 1 : something that is impromptu 2 : a musical composition suggesting improvisation

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